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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,151	12/26/2001	Johanna Fraki	442-010769-US(PAR)	8146

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PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

EXAMINER

GARCIA, ERNESTO

ART UNIT PAPER NUMBER

3679

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/033,151

Applicant(s)

FRAKI ET AL.

Examiner

Ernesto Garcia

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

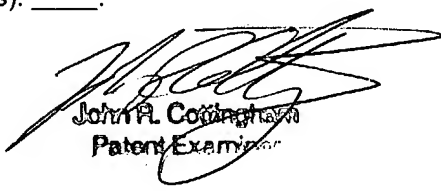
The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-26.Claim(s) withdrawn from consideration: 29.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


John F. Cunningham
Patent Examiner

Continuation of 5. does NOT place the application in condition for allowance because: the rejections to the claims is proper due to the combination of Filler et al. in view of Yu et al., see sheet appended.

Election/Restrictions

Applicant has requested consideration to the restriction requirement. In response, applicant is encouraged to file a petition as the restriction has been already reconsidered in the last office action. See 37 C.F.R § 1.144. After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181). As reminder, the examiner is taking the position for properness of the restriction in the fashion the applicant evaluated the necktie and a locomotive bearing. In another form of explaining, the necktie takes the place of the system and the locomotive takes the place of the computer program product. The analogy is the same and thus the inventions are distinct. Another corresponding analogy is a vehicle suspension and a ball-and-socket joint. These inventions are distinct and belong in different classes.

Applicant has argued that Filler et al. and Yu et al. fail to disclose "associating a digital collectible card with the user is based on the identification of the user in the cellular mobile communication network, which identification is received from the mobile phone". Applicant has elaborated on this argument by indicating that Filler et al. focus on a fixed network internet solution and that Filler et al. fail to teach a cellular mobile

communication network and a cellular mobile phone. If applicant believes that the mobile communication network and the cellular mobile phone were invented in this application, applicant is encouraged to file divisional applications to prosecute the mobile phone and the cellular communication network as Filler et al. do not teach these components. It is true that Filler et al. focus on a fixed network internet to trade digital cards. However, the swapping of digital files, which digital cards are, through the cellular is not new. Applicant has even stated that Filler et al. give one example of associating the card to the user in the remarks, which indicates that based on the identification of the user, a digital collectible card is associated with the user.

Applicant further argues that GSM technology has not been implemented similar to applicant's invention and includes all the features of the present invention. Applicant is reminded that GSM technology has had the capability of sending picture files, which either are in black and white, or color. These picture files are caller icons commonly used in older cellular phones with black and white screens.

Applicant further comments that Filler et al. was laid open to the public on March 2, 2000 and that no other similar solutions have been published. Is applicant admitting that Filler et al. have already solved the problem that applicant is involved? Yes, it appears that Filler et al. already trade collectible cards through a network. There's nothing novel in using a wireless network versus a wire network. It is true that Filler et

al. do not teach mobility. However, Yu et al. is used to teach what Filler et al. fail to do, swapping digital files through mobile phones.

Applicant has argued that the action fails to identify any specific passage or portion of Yu et al. as being pertinent. Applicant is reminded that 706.02(J)(A) says: the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate. It does not state that the relevant column or page number "must" be recited. One of ordinary skill in the art can just review Figure 1 of Yu et al. to find teachings.

Applicant has argued that Yu et al. do not disclose any digital trading card. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argued the reference to Yu et al. as having a field of endeavor not being the same. In response to applicant's argument that Yu et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir.

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1992). In this case, the pertinent problem the applicant was concerned is transferring digital files between two cell phones in a cellular communication network. Fuller et al. already teach trading cards using digital devices.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

June 25, 2004